

REMARKS/ARGUMENTS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 4-9 are currently pending. Claims 1-3 were previously canceled without prejudice or disclaimer. Claims 4 and 5 have been amended to address formal objections raised in the outstanding Action without the introduction of any new matter.

In the outstanding Office Action, Claims 4-9 were objected to because of informalities in Claims 4 and 5 and Claims 4-9 were rejected under 35 U.S.C. § 102(e) as being anticipated by Ejima et al. (U.S. Published Patent Application No. 2003/0103148, hereinafter Ejima).

The objection to informalities in Claims 4 and 5 have been corrected by adopting the suggestions in the outstanding Action. Accordingly, withdrawal of the objection to Claims 4-9 is respectfully submitted to be in order.

The rejection of Claims 4-9 under 35 U.S.C. § 102(e) as being anticipated by Ejima is traversed as Ejima does not teach all of the subject matter of base independent Claim 4.

For example, base independent Claim 4 requires, *inter alia*, an image scanning apparatus including:

- a display selecting section for displaying unitarily an item of additional information to be added to image data taken by said image data scanning section and a content corresponding to said item, and for selecting the displayed additional information and updating the selected additional information; and

- a recording medium for recording as one file the additional information attached as a header of the image data taken in the image scanning section,

This claim language clearly defines that the “item of additional information” is “to be added to image data taken by said image data scanning section” and that the “recording medium” records “the additional information attached as a header of the image data taken in

the image scanning section” all “as one file.” To further clarify this language, Claim 4 ends with the clause “the additional information selected and updated in the display selecting section is attached as the header of the image data taken in the image scanning section and is recorded in the recording medium as the one file.”

Page 3 of the outstanding Action refers to paragraphs [0177]-[0184], the LCD 6, and Figs. 6, 9, and 11-16 with apparent regard to the display selecting section of Claim 4 that defines the claimed “additional information.” As the LCD 6 is referred to in the outstanding Action and is the only relevant part of Fig. 6 as to displaying, it is assumed that LCD 6 is being suggested to correspond to the displaying, selecting, and updating required to be performed by the display selecting section. However, it is not clear what exactly is relied on in paragraphs [0177]-[0184] (and/or Figs. 9 and 12-16 mentioned therein) as corresponding to the claimed “additional information.”

Paragraph [0177] is concerned with the displaying a table screen on the LCD 6 (such as the one shown in FIG. 9) and selecting “a predetermined thumbnail image using the pen 41’ so that “information corresponding to the selected thumbnail image is supplied to the CPU 39” that “reads the image data corresponding the thumbnail image which is selected and stored in the memory card 24, which image data is transferred to the frame memory 35.” Thus, “the image corresponding to the selected thumbnail image is displayed on the screen of the LCD 6 as shown in FIG. 12.”

While displaying and selecting of a thumbnail image is suggested, there is no updating and no suggestion of the thumbnail image being “attached as the header of the image data taken in the image scanning section” or the recording of both this header and image data taken in the image scanning section being recorded “in the recording medium as the one file.”

Paragraph [0178] is concerned with determining if “existing line drawing data correlated to the image currently displayed on the screen of the LCD 6 and stored in the memory card 24 [i.e. the selected thumbnail image that is displayed on the screen of the LCD 6 as shown in FIGS. 12 and 13] is present.” Again, there is no updating of the thumbnail image or the line drawing data and no suggestion of the thumbnail image or line drawing data being “attached as the header of the image data taken in the image scanning section” or the recording of both this header and image data taken in the image scanning section being recorded “in the recording medium as the one file.”

Paragraph [0179] is concerned with displaying a selected thumbnail image with a correlated with an overlying line drawing image as shown in Fig. 14. Again, there is no updating of the thumbnail image or the line drawing image and no suggestion of the thumbnail image or line drawing image being “attached as the header of the image data taken in the image scanning section” or the recording of both this header and image data taken in the image scanning section being recorded “in the recording medium as the one file.”

Paragraph [0180] is concerned with the case that there is no line drawing data correlated to the selected thumbnail image currently displayed by LCD 6 which results in the paragraph [0181] new input by the user of line drawing data. This new line drawing data can be displayed with stored line drawing data so that both are shown overlaid on LCD 6 as shown in Fig. 15 while if there is no stored line data to add to the thumbnail image display, this is shown by Fig. 16 as discussed in paragraph [0183]. While paragraph [0184] teaches canceling the new line drawing data, canceling is not seen to be reasonably readable as the claimed updating and if it is canceled it is not “attached as the header of the image data taken in the image scanning section” nor can there be any recording of this non-existing canceled new drawing data header and image data taken in the image scanning section “in the recording medium as the one file.”

Apparently realizing that at least the recording requirements of Claim 4 are not taught as to relied on paragraphs [0177]-[0184], the LCD 6, and Figs. 6, 9, and 11-16, the outstanding Action turns to memory card 24, Fig. 6, and paragraphs [0129], [0130], 0154], and [0211]. However, these teachings do not cure the lack of the teaching of any updating of “the additional information” information of Claim 4 on LCD 6 nor do they meet the above noted Claim 4 requirement that “the additional information” must be “attached as the header of the image data taken in the image scanning section” and then recorded together “in the recording medium as the one file.”

Paragraph [0129] is further directed to a different aspect from that of paragraphs [0177]-[0184] as it is concerned with memo information that is input by the pen 41 when a shooting image is already displayed on the LCD 6, and not with the table screen on the LCD 6 (such as the one shown in FIG. 9) and the paragraph [0177] selecting of “a predetermined thumbnail image using the pen or the line drawing data or the combined images of line drawings and thumbnail image of paragraphs [0177]-[0184]. Instead, the memo information of paragraph [0129] is “synthesized (combined) with the shooting image information by the frame memory 35 and displayed together on the LCD 6.” While there is a supply of this memo information synthesized with the shooting image information along with header information to the memory card taught by paragraph [0130], this synthesized memo information and shooting image information recording with a header do not correspond to the Claim 4 requirements for “the additional information” to be selected and updated in the display selecting section before being “attached as the header of the image data taken in the image scanning section” before the required recording of this image data with the attached header of the Claim 4 defined additional information “in the recording medium as the one file.”

To whatever extent that paragraph [0211] teaches that “the line drawing data is recorded in the memory card 24 as one file,” this line drawing data is associated with thumbnail images, not with the “image data taken in the image scanning section” and, again, the line drawing data is not attached to anything as a header. Moreover, the line drawing data is different from the “memo information that is input by the pen 41” of paragraph [0129].

Similarly, paragraph [0154] is concerned with the line drawing, not the “memo information that is input by the pen 41” and the header mentioned here is simply one indicating a “recording date of the sound information is recorded with the line drawing information in the line drawing information recording area of the memory card 24.”

Also, the headers mentioned in paragraphs [0209]-[0213] noted on page 4 of the outstanding action all deal with the line drawing and dates as header information, where this line drawing data is associated with thumbnail images (as noted above), not with the “image data taken in the image scanning section” and this line drawing data is not itself attached to anything as a header. Moreover, the line drawing data is different from the “memo information that is input by the pen 41” of paragraph [0129].

It appears that the outstanding Action is improperly picking isolated disclosures of different aspects of the disclosure of Ejima and combining these isolated disclosures of different aspects in ways not taught or suggested by Ejima. This is improper because anticipation requires the citation of a single prior art reference that discloses each and every element arranged together exactly as in the claimed arrangement. *See In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990); *Lindemann Maschinen Fabrik GMBH v. American Hoist & Derrick Co.*, 221 USPQ 481 (Fed. Cir. 1984); *Ex parte Gould*, 6 USPQ2d 1680 (Bd. Pat. App. & Int. 1987); and *Ex parte Osmond*, 191 USPQ 334 (Bd. Pat. App. & Int. 1973). Thus, and as fully explained by the Board in *Osmond*, at 191 USPQ 336, isolated features having no teaching in the reference containing them that there is any reason to combine them into a

single combination cannot be said to anticipate a claimed invention simply because these unconnected features all appear in one reference. There must always be something in the reference directing the person skilled in the pertinent art to make the selections necessary from all the isolated disclosures of the reference to formulate a combination having the specific combination of features claimed.

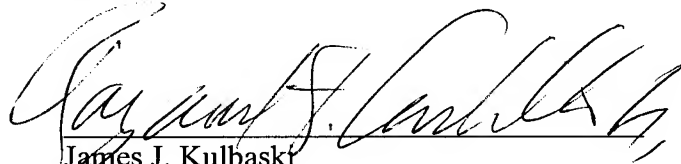
Accordingly, as Ejima does not disclose each and every element arranged together exactly as in the claimed arrangement and fails to meet all of the claim limitations based upon the teachings relied upon in the outstanding Action, no prima facie case of anticipation has been established as to the subject matter of independent Claim 4 and withdrawal of the rejection of Claim 4 under 35 U.S.C. § 102(e) as being anticipated by Ejima is, therefore, respectfully requested.

As Claims 5-9 all depend directly on independent Claim 4, they patentably define over Ejima at least for the reasons noted above as to parent Claim 4. In addition these dependent claims all add further features that are also not taught or suggested by Ejima and patentably define there over for this reason as well. Accordingly, withdrawal of the rejection of Claims 5-9 under 35 U.S.C. § 102(e) as being anticipated by Ejima is, therefore, also respectfully requested.

Consequently, in light of the above discussion, the outstanding grounds for objection and rejection are believed to have been overcome and the application is believed to be in condition for formal allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to read "James J. Kulbaski", is written over a horizontal line.

James J. Kulbaski
Registration No. 34,648
Attorney of Record

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413-2220
(OSMMN 06/04)
JJK:RFC\jmp

Raymond F. Cardillo, Jr.
Registration No. 40,440